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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------------|----------------------|---------------------|------------------|
| 10/509,074 | 10/14/2005 | Genhui Chen | W453 0007/GSO | 1249 |
| 720 | 7590 | 08/13/2009 | | |
| YOEN, WIGGS, GREEN & MUTALA LLP | | | | |
| 480 - THE STATION | EXAMINER | | | |
| 601 WEST CORDOVA STREET | QAZL, SABIHA NAJM | | | |
| VANCOUVER, BC V6B 1G1 | ART UNIT | PAPER NUMBER | | |
| CANADA | 1612 | | | |
| | | | | |
| NOTIFICATION DATE | DELIVERY MODE | | | |
| 08/13/2009 | ELECTRONIC | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mail@patentable.com

| | | |
|------------------------------|--------------------------------------|------------------------------------|
| Office Action Summary | Application No. 10/509,074 | Applicant(s) CHEN ET AL. |
| | Examiner Sabiha Gazi | Art Unit 1612 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 13 May 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 22 and 24-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 24-27 is/are allowed.
 6) Claim(s) 22 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s)/Mail Date <u>5/13/09; 6/23/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Non Final Office Action

Claims 22 and 24-27 are pending. New claims are added. Amendments are entered. Claims 24-27 are allowed. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Summary of this Office Action dated August 1, 2009

1. Continued Examination under 37 CFR 1.114
2. 35 USC § 103(a) Rejection
3. Response to Remarks
4. Communication
- 5.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/09 has been entered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over WEBSTER et al.¹ and GODFREY². Both the references teach dithioliopyrrolones and their derivatives as presently claimed.

WEBSTER teaches dithioliopyrroles as antineoplastic agents. See the entire document especially abstract, figure 1 on page 1, figures 2 and 3 on page 2, examples and claims.

¹ WO 99/12543

GODFREY teaches these compounds as fungicides. See the entire document especially compounds of formula (1) on page 1, Table 1 on page 3continued to page 5scheme 1 on page 7examples and claims.

Instant claims are generically taught by the prior art.

Instant claims differ from the reference in that they are of different generic scope. It had been held by Courts that the indiscriminate selection of "some" from among "many" is considered *prima facie* obvious. In re Lemin, 141 USPQ 814 (1964); National Distillers and Chem. Corp. V. Brenner, 156 USPQ 163.

The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the genus of the above cited references with the expectation of obtaining additional beneficial compounds. The instant claimed compounds would have been suggested to one skilled in the art.

One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render *prima facie* obvious a species falling within the genus. In re Susi, 440 F.2d 442, 445, 169 USPQ 423,

² GB 2,173,499

425 (CCPA 1971), followed by the Federal Circuit in Merck & Co. V. Biocraft Laboratories, 874 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have obvious to one skilled in the art.

Response to Remarks

Applicants' arguments have been fully considered but were not found persuasive regarding obviousness rejection. Since claims are drawn to compounds therefore present claims are considered obvious for the same reasons as set forth in the previous office action.

In order to advance the prosecution Applicant may consider calling the Examiner to discuss the remaining issues.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/
Primary Examiner, Art Unit 1612

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